

SN. 10/647,094

ATTORNEY DOCKET No. FUJI:270

REMARKS

Claims 1, 4-14, and 16-20 are now pending in this application for which applicant seeks reconsideration. Claims 14-19 have been withdrawn as directed to the non-elected invention (method).

Amendment

Claims 1 and 14 have been amended, claims 2, 3 and 15 have been canceled, and new claim 20 has been added. Claim 1 now incorporates the subject matter of claims 2 and 3, while further defining the elements contained in the at least one of the cobalt layers and the noble metal layers. Specifically, it now calls for at least one oxide and at least one element selected from a group. The elements in the group have been reduced. Claim 14 now incorporates the subject matter of claims 2/15 and 3. New claim 20 is a combination of part of original claims 1, 5, and 6. No new matter has been introduced.

Art Rejection

Claims 1, 4-9, 11, and 12 were rejected under 35 U.S.C. § 102(e) as anticipated by Litvinov (USP 6,656,613). Claims 1, 2, 4-9, and 11 were rejected under § 102(e) as anticipated by Maesaka (USP 6,596,418). Claims 2, 3, and 13 were rejected under § 103(a) as unpatentable over Litvinov. Finally, claim 10 was rejected under § 103(a) as unpatentable over Litvinov in view of Hanawa (USPA 2002/0076579).

As claim 1 now recites that the at least one of the cobalt layers and the noble metal layers contains both at least one oxide and at least one element selected from the group consisting of Ru, Mo, Mn, Si, and Ni, the rejection based on Maesaka has been rendered moot. Note that Maesaka teaches using only boron oxide as an additive to the magnetic (cobalt and platinum) layers.

Claim 1 now incorporates claims 2 and 3. The examiner states that Litvinov teaches all of the limitations of these claims, except for the particular amount of silicon oxide in the Co and Pt/Pd layers. In this respect, the examiner asserts that the claimed ranges of silicon oxide in the

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Co and Pt/Pd layers would have been an obvious optimization task. Applicant disagrees with this assessment because the examiner does not provide any objective evidence that the claimed range would have optimized Litvinov's magnetic layers. Note that original claim 3 called for the cobalt layers to contain silicon oxide ranging from 5 to 11 mol%, and the noble metal layers to be composed of platinum, containing silicon oxide ranging from 1 to 8 mol%. There is absolutely no teaching or suggestion anywhere that these ranges would have provided an optimal result in Litvinov or that such ranges would have been even desirable. As the examiner has failed to provide any evidence that the claimed range would have been desirable or provided an optimal result, applicant submits that the examiner has failed to provide a *prima facie* case of obviousness. Applicant submits that claim 14 patentably defines over Litvinov the same reasons set forth above.

Hanawa would not have alleviated the Litvinov's shortcomings identified above.

New claim 20 incorporates part of original claims 1, 5 and 6, namely limiting the underlayer to a Ru film. Neither Litvinov nor Maesaka would have taught an Ru underlayer.

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Conclusion

Applicant submits that the pending claims patentably distinguish over the applied references and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicant urges the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,



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